DOCKET NO.: 286220US6PCT/

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Ryohei YASUDA

GROUP: 2169

SERIAL NO: 10/569,227

EXAMINER: F. QUADER

FILED: February 23, 2006

FOR: CONTENT ACQUISITION METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
RYOHEI YASUDA	: EXAMINER: QUADER, FAZLUL
SERIAL NO: 10/569,227	:
FILED: FEBRUARY 23, 2006	: GROUP ART UNIT: 2164
FOR: CONTENT ACQUISITION METHOD	:

REMARKS ACCOMPANYING PRE-APPEAL BRIEF CONFERENCE REQUEST

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant respectfully requests that a Pre-Appeal Brief Conference Request be initiated relative to the above-identified patent application. This request is being filed with a Notice of Appeal.

The Final Action mailed October 17, 2008, presented a rejection of Claims 1-8 under 35 U.S.C. §103 as being unpatentable over Nakayama (U.S. Patent No. 7,117,253, hereinafter Nakayama) in view of Sakata (U.S. Patent Publication No. 2004/0064507, hereinafter Sakata). On November 26, 2008, Applicant filed a Response and Request for Reconsideration under 37 C.F.R. §1.116. In the Advisory Action issued December 24, 2008, the Office has maintained the final rejection, providing the exact same justification as previously presented, without responding to the substance of the Applicant's previously

submitted distinctions. Furthermore, the justification for the rejection is still maintained based upon and improper reference to the claims of prior art references.[1]

Applicant's Claim 1 recites, *inter alia*, a content acquisition method, including:

> . . . a division position determination step of **determining division start positions and division end positions specifying division parts of said content data** to request said content data in divided form from said plurality of content provision apparatus, **based on the number of pieces of said address information and said data size information received by said information reception step;**
>
> a division part request information transmission step of **transmitting division part request information including content identification information of said content data, and said division start positions and division end positions** of said division parts of said content data, such that **each said division part is requested from different** said content provision apparatus; . . . (emphasis added)

Nakayama describes a client server arrangement in which information is transferred from a server side to a client side. In applying this description to the claims of record, the Office has confusingly and repeatedly identified column 4, lines 16-24 of this reference to correspond to the bolded claimed features above. The cited portion of the Nakayama reference describes that a WWW browser is utilized to browse HTTP contents. This passage also explains that streaming content is content which is continually transferred between devices, and that streaming data is divided into "clips".

The Office Action is completely silent with respect to any articulable rationale as to how the cited art relates to the bolded claim features above.

Simply stated, the claims require that division start positions and division end positions are **determined** for specifying division parts of content data such that the content data can be requested, in divided fashion, from a plurality of **DIFFERENT** content position

[1] Advisory Action of December 24, 2008 at page 2.

apparatuses. **The division is based on a number of pieces of address information and data size information**. The start positions and end positions of the content data is then **TRANSMITTED** as division part request information, including content identification information of the content data, such that each division part is requested from a different content division apparatus. The obtained divided content is then combined upon reception.

In the Advisory Action at page 2, the Office still does not provide any explanation relative to the above bolded features and their alleged presence at column 4, lines 16-24 of Nakayama. Instead, the Advisory Action merely reiterates the rejection and continues to base the rejection on citations to claims of prior art patents. It is entirely unclear to the Applicant what column 4, lines 16-24 of Nakayama has to do with the above bolded claim features.

Furthermore, the Office is basing the present rejection on reference to a patent claim, this is clearly improper. The Federal Circuit has characterized analysis of prior art patent claims with respect to the patentability of an Application as "a plainly indefensible line of reasoning" (In Re Benno, 226 U.S.P.Q. 683, 686, Fed. Cir. 1985) and further stated that:

> The scope of a patent's claim determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically, or in general terms, so as to convey intelligence to one capable of understanding (*See* Benno at 686) (emphasis added)).

The Office seems to be taking the position that "clips" are a form of divided data, yet there is absolutely no reference or articuable rationale as to how these portions of Nakayama can be said to divide content data into start positions and end positions **BASED ON** a number of pieces of address information and data size information. Additionally, there is no explanation or articuable rationale as to how Nakayama **TRANSMITS** such division start positions and division end positions such that each divided part is requested from a **different content division apparatus** as required by the independent claims.

Clearly, Nakayama does not disclose or suggest **DETERMINING** division start positions or division end positions of content data based upon address information and data size. Additionally, Nakayama does not disclose or suggest transmitting such information such that each division part is requested from a different content provision apparatus and combined upon reception as claimed.

As Sakata has not been relied upon for describing any of the aforementioned claimed features, nor does Sakata remedy any of these deficiencies as discussed above, Applicant respectfully requests that the rejection of Claims 1-8 under 35 U.S.C. § 103 be withdrawn and prosecution be reopened to avoid further appeal proceedings.

Respectfully submitted,

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